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OFFICE OF PETITIONS

In re Application of
James O. Kelley et al.
Application No. 10/757,663
Filed: January 13, 2004
Attorney Docket No. sf 53.2-3
Title: MODULAR FURNITURE SYSTEM

DECISION ON PETITION UNDER
37 C.F.R. §1.53

This is a decision on the petition filed June 1, 2004, under 37 C.F.R. 1.53, requesting that the above-identified application be accorded a filing date of January 13, 2004, with Figure 43 submitted with the instant petition considered as part of the original disclosure of the application.

The application was deposited on January 13, 2004. However, on April 21, 2004, the Office of Initial Patent Examination (OIPE) mailed a "Notice of Omitted Item(s) in a Nonprovisional Application (notice)," stating that the application had been accorded a filing date, and advising applicants that the application appeared to have been deposited without Figure 43. With the instant petition, Petitioner has submitted Figure 43 along with authorization to charge the petition fee to a Deposit Account.

Petitioner states that although Figure 43 was omitted on filing, it was constructively included through incorporation by reference.

The Office allows an applicant to rely upon an incorporation by reference of a parent application when a portion of the child application has been inadvertently omitted. It is noted that the application transmittal letter identifies this application as a continuation of a prior application, but fails to list the serial number of the parent. The specification identifies this application as a continuation of application 08/840,960 and sets forth that the disclosure of the parent is incorporated by reference. Section 201.06(c) of the MPEP sets forth, in part:

an applicant may incorporate by reference the prior application by including, in the continuation or divisional application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The incorporation by reference statement can only be relied upon to permit the entering of a portion of the

prior application into the continuation or divisional application when the portion of the prior application has been inadvertently omitted from the submitted application papers in the continuation or divisional application. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuation or divisional application to include any subject matter in such prior application(s), without the need for a petition provided the continuation or divisional application is entitled to a filing date notwithstanding the incorporation by reference.

(Emphasis added).

If petitioner desires for the examiner to consider the missing figure which was not submitted as part of the original disclosure, then Petitioner may submit that page via an amendment. Any such amendment will, of course, be reviewed by the examiner for new matter¹. The amendment is not new matter if the substance was a part of the disclosure of the prior application.

For these reasons, the petition under 37 CFR 1.53(b) is dismissed.

Figure 43, submitted with the instant petition, will be not entered. Should petitioner wish for this page to be entered, an amendment must be filed. The original application papers will include only those application papers present on the date of deposit. The petition fee of \$130.00 will not be refunded, as this petition was not necessitated by any error on the part of the Office.

Unfortunately, the Deposit Account Petitioner has given to the Office is not an active account. As such, the Application will not be returned to the Office of Initial Patent Examination for further processing.

Petitioner must submit a response to this decision, along with the required petition fee within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. 1.53". This is not a final agency action within the meaning of 5 U.S.C 704.

Failure to submit the petition fee with this response in the time frame indicated above will result in the abandonment of this application.

The renewed petition should display "Please deliver to Paul Shanoski, c/o Office of Petitions" in a prominent manner.

To help assure prompt and proper attention to your response, please see Request for Alert Concerning Submitted Petitions, 1282 Official Gazette (May 18, 2004) for further information on how to assist the Office in delivering your submission to the correct location. The Petitioner may wish to consider telephoning the undersigned one month after the submission is made to confirm that the documents were properly delivered.

Any renewed petition may be submitted by mail², hand-delivery³, or facsimile⁴.

¹ See MPEP 608.02(h) and 608.04.

² Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

³ Customer Window, Mail Stop Petition, Crystal Plaza Two, Lobby, Room 1B03, Arlington, Virginia 22202.

⁴ (703) 872-9306 - please note this is a central facsimile number, and as such, there will be a delay in the delivery of the facsimile to the undersigned, which could be as much as one month.

The application file will be retained in the Office of Petitions for two (2) months.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (703) 305-0011. Please note that on approximately September 28, 2004, the Office of Petitions will relocate to the new PTO location in Alexandria. Although the mailing address will remain the same, the general phone number for the Office of Petitions which should be used for status requests will change to 571-272-3282, and the telephone number for the undersigned will change to 571-272-3225.



**Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office**